

REMARKS

Claims 1-14 are pending in the subject application. Claim 8 is currently amended merely for purposes of proper antecedent basis, as described in greater detail below. As such, no new matter has been added via the present Amendment. No claims are cancelled, withdrawn, or added via the present Amendment.

Claims 4, 7 and 11-14 are objected to as being dependent upon a rejected base claim, but are indicated as being allowable if rewritten in independent form. The Applicants thank the Examiner for such allowable subject matter.

Claim 8 stands rejected under 35 U.S.C. § 112, ¶2, as being indefinite because claim 8 lacks antecedent basis for the claim element “optical waveguide.” Applicants have amended the dependency of this claim such that claim 8 now depends from claim 7, which has proper antecedent basis for the claim element “optical waveguide,” thus obviating the Examiner’s rejection under § 112.

Claims 1-3, 5, 6, and 8-10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pat. No. 7,534,820 to Kohno et al. (the ‘820 patent). However, the Applicants respectfully point out that the ‘820 patent is not prior art. In particular, the ‘820 patent is a continuation-in-part of Application No. PCT/JP2004/013707, which was filed on September 13, 2004. The subject application claims priority to foreign application JP 2003-412452, filed on December 10, 2003, which antedates the filing date of the parent application (i.e., Application No. PCT/JP2004/013707) of the ‘820 patent. As such, the ‘820 patent does not qualify as prior art under either 35 U.S.C. §§ 102(a) or 102(b). The Applicants assume, then, that the Examiner relied upon the ‘820 patent as prior art under § 102(e) because the patent application to which the

‘820 patent claims priority was filed under the Patent Cooperation Treaty, designated the U.S. and published in English. The critical date for PCT Applications relative to 35 U.S.C. § 102(e) is the filing date of the PCT Application (provided that the PCT Application publishes in English). As set forth above, the filing date of the PCT Application to which the ‘820 patent claims priority September 13, 2004. However, the subject application has a claim of priority to JP 2003-412452, which was filed on December 10, 2003, i.e., before the filing date of the PCT Application to which the ‘820 patent claims priority. Thus, the ‘820 patent is not prior art.

To perfect the subject application’s claim of foreign priority, the Applicants submit herewith an English translation of JP 2003-412452, along with a “Statement of Accuracy of the Translation” (hereinafter “Statement”) executed by a person familiar with the Japanese language to attest to the accuracy of the translation pursuant to 37 CFR §1.55. The Applicants’ submission of the English language translation of JP 2003-412452 and the Statement establishes the proper claim of priority in the subject application to JP 2003-412452 and antedates the PCT Application to which the ‘820 patent claims priority such that the rejection over the ‘820 patent must be withdrawn.

Notwithstanding the above, the Applicants also note that the ‘820 patent is directed toward a photocurable composition containing an organic polymer (A) having an epoxy group and/or epoxy group-containing silicon group and a cationic photoinitiator (B). The Examiner contends that the difference between the claims of the subject application and the ‘820 patent is that the ‘820 patent doesn’t “teach the specific mol percent limitations of phenyl and epoxy groups.” Although it is true that the ‘820 patent fails to teach the specific mol percent limitations of phenyl and epoxy groups, this is merely one of the many failures of the ‘820 patent to teach,

disclose, or even suggest the claimed invention. Said differently, there are more differences between the subject invention and the '820 patent than this one difference identified by the Examiner.

The organic polymer (A) of the '820 patent is synthesized by one of the following processes: (I) an organic polymer terminated with an unsaturated group is synthesized and then subjected to addition reaction of a hydrosilane compound containing one hydrosilyl group on average which has an epoxy group and/or an oxetane group; or (II) an organic polymer is subjected to terminal addition reaction of a hydrosilane compound having two or more hydrosilyl groups in its molecule and then addition reaction of an epoxy compound having an unsaturated group such as an allyl group or the like with unreacted hydrosilyl groups. (See column 11, lines 39-49 of the '820 patent).

The organic polymer (A) of the '820 patent having a structure represented by formula (1), (2), or (3) at an end is synthesized by reacting an organic polymer having terminal unsaturated groups, such as allyl groups, and a hydrosilane compound represented by formula (8), (9), or (10), in the presence of a group VIII transition catalyst, such as a platinum catalyst. (See columns 12 to 15 and Synthesis Examples 5 and 6 of the '820 patent).

The hydrosilane compounds of the '820 patent are required to have at least one hydrosilyl group, and have a linear or cyclic structure. Notably, the epoxy-containing organopolysiloxane resin claimed in the subject application is represented by the following general formula: $(R^1R^2R^3SiO_{1/2})_a(R^4R^5SiO_{2/2})_b(R^6SiO_{3/2})_c(SiO_{4/2})_d$. Notably, this formula includes T units, i.e., $(R^6SiO_{3/2})$ units, which impart branching to the epoxy-containing organopolysiloxane resin. Such T units are not taught, disclosed, or even suggested by the '820 patent. Moreover, the epoxy-

containing organopolysiloxane resin of the subject application does not include hydrosilyl group(s), as expressly required by the '820 patent.

In view of the foregoing, the Applicants submit that claims 1-14 are both novel and non-obvious over the prior, including over the '820 patent. As such, the Applicants believe the subject application is in condition for allowance, and such allowance is respectfully requested.

This Amendment is timely filed; thus, it is believed that no additional fees are due. However, if necessary, the Commissioner is authorized to charge Deposit Account 08-2789 in the name of Howard & Howard Attorneys PLLC for any additional fees or to credit the account for any overpayment.

Respectfully submitted,

HOWARD & HOWARD ATTORNEYS PLLC

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